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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,346	12/21/2001	Blair R. Dobbie	46417.001018	4849

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EXAMINER	
LINDSEY, RODNEY M	
ART UNIT	**PAPER NUMBER**
3765	5

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No.	Applicant(s)	
	10/024,346	DOBBIE ET AL.	
	Examiner	Art Unit	
	Rodney M. Lindsey	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *18-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 June 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species of Figures 1-11 and Species of Figures 12-14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Kevin T. Duncan on May 21, 2003 a provisional election was made without traverse to prosecute the invention of Figures 1-11, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "15". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: in paragraph 0040, line 7 "28" it appears should be --30--, in paragraph 0043, lines 6-8 "32" and "34" it appears should be --44-- and --46-- and in paragraph 0062 "132" it appears should be --144--.

Appropriate correction is required.

6. The use of the trademark "VELCRO" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-6, 9-15, 16/13, 16/15, 17/13 and 17/15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kastendieck et al. in view of Weaver et al.

Note in Kastendieck et al. the mounting shell 16 interiorly padded at the cheek area 52 (see Figure 3) and attached by straps 36, 46, 48. Kastendieck et al. does not teach the use of an elastic strap. Weaver et al. teaches old the use of elastic straps in alternative to adjustable straps for likewise accommodating different head sizes (see column 3, lines 34-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the elastic straps of Weaver et al. for those of Kastendieck et al. to achieve the advantage of an alternative means of accommodating different head sizes. Regarding claim 2, claim 2 is not seen to set forth any structure of the apparatus not found in Kastendieck et al. and as modified. With respect to claim 3 note the use of plastic by Kastendieck et al. With respect to claims 4 and 5 note the contact points at the forehead, cheek and temporal areas of Kastendieck et al. With respect to claim 6 note the distribution of padding per Figure 3 of Kastendieck et al. With respect to claim 9 note the side 36 and top 46, 48 straps of Kastendieck et al. With respect to claim 10 note the

eyelets or slots for the straps 36, 46, 48 in the shell 16 of Kastendieck et al. With respect to claim 11 note the teaching of elastic straps by Weaver et al. as noted above. With respect to claim 12 note the use of buckles 84, 86, 88, 90 of Kastendieck et al. With respect to claim 13 note the accommodation of the helmet 14. With respect to claim 14 note the bridge between 52 and 18 of Kastendieck et al. With respect to claim 15 note the respective surfaces as claimed on the shell 16 of Kastendieck et al. With respect to claims 16/13 and 16/15 the mere limitation of a full face mask is not seen to set forth any structure of the apparatus not taught by Kastendieck et al. and as modified. With respect to claims 17/13 and 17/15 the mere limitation of a half face mask is not seen to set forth any structure of the apparatus not taught by Kastendieck et al. and as modified.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kastendieck et al. in view of Weaver et al. as applied to claim 6 above, and further in view of Dennis et al. Dennis et al. teaches old the use of a moisture wicking covering 20 for a head engaging pad. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pad of Kastendieck et al. with the moisture wicking covering 20 of Dennis et al. to achieve the advantage of controlling perspiration between the user and the pad.

10. Claims 8, 16/8 and 17/8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kastendieck et al. in view of Weaver et al. as applied to claim 6 above, and further in view of Strohm.

Strohm teaches that the use of a rot inhibitor or vinyl finish on a pad for engaging a head is old in the art (see column 4, lines 20-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the padding of Kastendieck et al. with the vinyl finish of

Strohm to achieve the advantage of inhibiting rot of the padding. With respect to claims 16/8 the mere limitation of a full face mask is not seen to set forth any structure of the apparatus not taught by Kastendieck et al. and as modified. With respect to claim 17/8 the mere limitation of a half face mask is not seen to set forth any structure of the apparatus not taught by Kastendieck et al. and as modified.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/024,650 in view of Kastendieck et al. and Weaver et al. Claims 1-21 of '650 are not seen to teach either the pad contacting the cheek or the elastic strap. Kastendieck et al. teaches old the pad contacting the cheek (see Figure 3). Weaver et al. teaches old the use of elastic straps (see column 3, lines 32-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus of claims 1-17 with the pad contacting the cheek of Kastendieck et al. to achieve the advantage of further stabilizing the apparatus with respect to a user's head. It would have been obvious to one of ordinary skill in

the art at the time of the invention to provide the apparatus of claims 1-17 with an elastic strap in the manner of Weaver et al. to achieve an alternative means of accommodating different head sizes.

This is a provisional obviousness-type double patenting rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note particularly, the bacteria/fungus inhibitors of Schiebl et al., the half mask arrangements of Ahlgren et al. and Pohlmann, the elastic straps of Walmer et al. and Pulju, the bridge at 20 of Turner and the padded and/or strapped apparatus of Mattes, Dor '204, Goodyear, Docking et al., Hanson et al., Martin, Deal, III, Dor '678, Cline, White, Nevius and Ainsworth et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Lindsey whose telephone number is (703) 305-7818. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (703) 305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.

Rodney M. Lindsey
Primary Examiner
Art Unit 3765

rml
May 22, 2003